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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/726,368	11/29/2000	Gregory J. Gagnon	PD-990271	5293

20991 7590 12/14/2004

THE DIRECTV GROUP INC  
PATENT DOCKET ADMINISTRATION RE/R11/A109  
P O BOX 956  
EL SEGUNDO, CA 90245-0956

EXAMINER
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RHODE JR, ROBERT E

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/726,368		GAGNON ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Rob Rhode		3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2004.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 - 5, 8 - 20, 23 - 35 and 38 - 52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 - 5, 8 - 20, 23 - 35 and 38 - 52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on ??? has been entered.

### ***Response to Amendment***

Applicant amendment of 11-22-04 amended the specification and claims 1, 16 and 31 and canceled claims 6 – 7, 21 – 22 and 36 - 37 as well as traversed rejections of Claims 1 – 5, 8 – 20, 23 – 35 and 38 - 52.

Currently, claims 1 – 5, 8 – 20, 23 – 35 and 38 - 52 are pending.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1 – 9, 11 – 24, 26 – 39 and 41 - 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis (US 6,275,268 B1) in view of Nel (US 6,363,364 B1) and further in view of Chatterjee (EP 0820206 A2).**

Claim 1 and related claims 16, 31 and 49 (CURRENTLY AMENDED), Ellis teaches a method and system of initializing a subscription television service comprising.

a) receiving, from a user an initiation of a purchase in a receiver connected to a presentation device:

b) in response to the receiving, activating software in the receiver, the software causing the receiver to display on the presentation device, a purchase screen having at least one field, wherein the receiver is further configured to:

i) receive broadcast signals through an input mechanism; and

ii) enable the presentation device to display the broadcast signals;

c) receiving from the user purchase information for a purchase in the at least one field into the receiver, wherein the purchase information identifies an initial television subscription service for an initial activation of the receiver and an initial television programming package for the receiver;

g) receiving in the receiver, authorization for the initial activation of the subscription television service for the initial activation of the receiver and initial television programming; and (see at least Abstract, Col 1, lines 16 -20 and 50 – 55, Col 26, lines 27 – 20 and Figures 9 – 10 and 43C - D). Please note the method and system of Ellis provide the capability to initiate the set top box and package without interacting with a

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customer service representative. Moreover in a reasonable broad interpretation of the claim language "initial television subscription service for an initial activation of the receiver and an initial television programming package for the receiver", Ellis discloses a software in a receiver, which provide the capability to purchase an initial television subscription serve such as Premium Services to be purchased by credit card., which is not subscribed by the user. Furthermore, this capability of activation of a device such as receiver for decode/communicate after receiving a registration is well known in the art.

While Ellis does disclose transmitting purchase information and credit card authorization, the reference does not specifically disclose a method and system of d) establishing a secure electronic connection, using a communication mechanism of the receiver that is different from the input mechanism that is used to receive broadcast signals, with a vendor; e) electronically transmitting the purchase information from the receiver through the secure electronic connection to the vendor, f) receiving a confirmation number from the vendor into the receiver, wherein the confirmation number confirms that the purchase has been allowed by the vendor.

On the other hand and in the same area of initializing a subscription television service, Nel teaches a method and system for d) establishing a secure electronic connection,

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using a communication mechanism of the receiver that is different from the input mechanism that is used to receive broadcast signals, with a vendor;

e) electronically transmitting the purchase information from the receiver through the secure electronic connection to the vendor,

f) receiving a confirmation number from the vendor into the receiver, wherein the confirmation number confirms that the purchase has been allowed by the vendor (see at least Abstract, Col 3, lines 41 – 57, Col 4, lines 4 – 15, Col 5, lines and Figures 2 - 5).

Please note that the receiver in Nel has a dual function such as receive and transmit.

Furthermore in a reasonably broad interoperation of the claim phrase “communication mechanism of the receiver that is different from the input mechanism that is used to receive broadcast signals” is that the transmit portion of the receiver/transmitter, which is different from the receive portion and thereby “different from the input”, which is the receiver portion. Thereby, Nel has a both a receive portion and different transmit portion, which is different from the input mechanism (i.e. receiver).

It would have been obvious to one of ordinary skill in the art to have provided the method and system of Ellis with the method and system of Nel to have enabled a method and system of initializing a subscription television service comprising.

a) receiving, from a user an initiation of a purchase in a receiver connected to a presentation device; b) in response to the receiving, activating software in the receiver, the software causing the receiver to display on the presentation device, a purchase screen having at least one field, wherein the receiver is further configured to:

i) receive broadcast signals through an input mechanism; and  
ii) enable the presentation device to display the broadcast signals;

c) receiving from the user purchase information for a purchase in the at least one field into the receiver, wherein the purchase information identifies an initial television subscription service for an initial activation of the receiver and an initial television programming package for the receiver; g) receiving in the receiver, authorization for the initial activation of the subscription television service for the initial activation of the receiver and initial television programming; and d) establishing a secure electronic connection, using a communication mechanism of the receiver that is different from the input mechanism that is used to receive broadcast signals, with a vendor; e) electronically transmitting the purchase information from the receiver through the secure electronic connection to the vendor, f) receiving a confirmation number from the vendor into the receiver, wherein the confirmation number confirms that the purchase has been allowed by the vendor; h) using the received authorization, activating and configuring the receiver to allow the display of the subscription television services. Ellis discloses the limitations of receiving an initiation of a purchase by a user and the activation of the software to enable receive and display as well as identifying an initial subscription service and activating the receiver (Col 1, lines 16 -20 and 50 – 55, Col 26, lines 27 – 20 and Figures 9 – 10 and 43C – D). Nel discloses a method and system for d) establishing a secure electronic connection, using a communication mechanism of the receiver that is different from the input mechanism that is used to receive broadcast signals, with a vendor; e) electronically transmitting the purchase information from the receiver through

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the secure electronic connection to the vendor, f) receiving a confirmation number from the vendor into the receiver, wherein the confirmation number confirms that the purchase has been allowed by the vendor (see at least Abstract, Col 3, lines 41 – 57, Col 4, lines 4 – 15, Col 5, lines and Figures 2 - 5). Therefore, one of ordinary skill in the art would have been motivated to extend the method and system of Ellis with a method and system for d) establishing a secure electronic connection, using a communication mechanism of the receiver that is different from the input mechanism that is used to receive broadcast signals, with a vendor; e) electronically transmitting the purchase information from the receiver through the secure electronic connection to the vendor, f) receiving a confirmation number from the vendor into the receiver, wherein the confirmation number confirms that the purchase has been allowed by the vendor.

The combination of Ellis and Nel disclose and teach substantially the claimed invention.

While the combination does disclose receiving authorization for the subscription of Premier Services, the combination does not specifically disclose a method and system for h) using the received authorization, activating and configuring the receiver to allow the display of the subscription television services.

On the other hand, Chatterjee teaches a method and system for h) using the received authorization, activating and configuring the receiver to allow the display of the subscription television services (see at least 57, first page). Please note that Chatterjee



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does not specifically disclose television. However, Chatterjee does disclose using the received authorization, which is associated with the device (transmitter/receiver/decoder) of a mobile phone. In that regard, it would have been obvious to one of ordinary skill in the art to extend the method of Chatterjee with television and thereby have provided additional applications for the method and system, which will also increase the potential revenue for the method and system.

It would have been obvious to one of ordinary skill in the art to have provided the combination of Ellis and Nel with the method and system of Chatterjee to have enabled h) using the received authorization, activating and configuring the receiver to allow the display of the subscription television services. The combination of Ellis and Nel disclose the claim limitations of receiving, purchasing, displaying and authorizing of a purchase. Chatterjee discloses a method and system for h) using the received authorization, activating and configuring the receiver to allow the display of the subscription television services (see at least 57, first page). Therefore, one of ordinary skill in the art would have been motivated to extend the combination of Ellis and Nel with a method and system for h) using the received authorization, activating and configuring the receiver to allow the display of the subscription television services. Thereby, the activation occurs after the authorization to use the device and thereby enhances security for the method and system, which precludes unauthorized users.

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Regarding claim 2, 17 and 32, Ellis teaches the activation of the purchase screen is received from a user using a remote control device (Figure 3 and 4).

Regarding claims 3, 18 and 33, Ellis teaches the purchase information comprising a type of credit card; a credit card number and an expiration date (Figure 43C).

Regarding claims 4, 19 and 34, Nel teaches the additional information comprises merchandise information for merchandise to be purchased from the vendor and claims 5, 20 and 35 wherein the additional purchase information comprises service information for a service to be purchased from the vendor (Col 6, line 42 – Col 7, line 24).

Regarding claims 8, 23 and 38, Chatterjee teaches receiving, in the receiver, authorization for the service from the vendor; and configuring the receiver to allow the display of the authorized services (see at least 57).

Regarding Claims 9, 24 and 39, Nel teaches a verifying that all the required purchase information has been received (Col 3, lines 55 – 57).

Regarding Claims 11, 26 and 41, Nel teaches a method and system of causing one or more on screen actions taken by the receiver (Col 3, lines 41 – 51).

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Regarding Claims 12, 27 and 42, Ellis teaches a storing the confirmation number into a purchase history screen in the receiver that allows a customer to view a purchase information (Col 5, lines 8 – 10).

Regarding Claims 13, 28 and 43, Nel does not explicitly disclose the vendor is a credit card company. However, Nel does disclose a vendor with financial transactions with account payment (Col 1, lines 45 – 49, Col 4, lines 59 – 67 and Figure 5). In that regard, it would have been obvious to one of ordinary skill in the art at the time of the invention to extend the method and system of Nel to have included a vendor, which is a credit card company. In this regard, the credit card company will increase the reasons for using their credit card and thereby increase revenues.

Regarding claims 14, 29 and 44, Chatterjee discloses the receiver is an integrated receiver/decoder (57).

Regarding Claims 15, 30 and 45, Nel discloses the presentation device is a television (Col 5, lines 48 – 57).

Regarding claims 46 – 48, Ellis teaches a method and system wherein all of the steps of the method are automated without interacting with personnel from the vendor (Figures 9 and 10).

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Regarding claim 50, Ellis teaches wherein the vendor receives the confirmation number from a credit card company (Figure 43C).

Regarding claim 52, Ellis teaches wherein the good or service comprises an initial subscription and activation of a television programming package from a provider (Figures 9 and 10).

**Claims 10, 25 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Ellis, Nel and Chatterjee as applied to claims 1, 16 and 31 above, and further in view of Toyosawa (US 6,317,793 B1).**

The combination of Ellis, Nel and Chatterjee substantially disclose and teach the applicant's invention.

However, the combination does not specifically disclose and teach wherein establishing a secure connection comprises obtaining a dial tone through a modem connected to the receiver; dialing a phone number corresponding to the vendor selected, wherein the phone number id stored in the receiver; and establishing a secure connection with computer system of the vendor at the phone number dialed

On the other hand and regarding Claims 10, 25 and 40, Toyosawa teaches wherein establishing a secure connection comprises obtaining a dial tone through a modem

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connected to the receiver; dialing a phone number corresponding to the vendor selected, wherein the phone number id stored in the receiver; and establishing a secure connection with computer system of the vendor at the phone number dialed (see at least Col 2, lines 32 – 64).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the combination of Ellis, Nel and Chatterjee with the method and system of Toyosawa to have enabled a method and system wherein establishing a secure connection comprises obtaining a dial tone through a modem connected to the receiver; dialing a phone number corresponding to the vendor selected, wherein the phone number id stored in the receiver; and establishing a secure connection with computer system of the vendor at the phone number dialed. The combination of Ellis and Nel disclose the claim limitations of receiving, purchasing, displaying and authorizing of a purchase. Toyosawa teaches wherein establishing a secure connection comprises obtaining a dial tone through a modem connected to the receiver; dialing a phone number corresponding to the vendor selected, wherein the phone number id stored in the receiver; and establishing a secure connection with computer system of the vendor at the phone number dialed (see at least Col 2, lines 32 – 64). Therefore, one of ordinary skill in the art would have been motivated to extend the combination of Ellis, Nel and Chatterjee with a method and system wherein establishing a secure connection comprises obtaining a dial tone through a modem connected to the receiver; dialing a phone number corresponding to the vendor selected, wherein the phone

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number id stored in the receiver; and establishing a secure connection with computer system of the vendor at the phone number dialed.

**Claim 51 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Ellis, Nel and Chatterjee as applied to claim 49 above, and further in view of Koreeda (US 5,890,137).**

The combination of Ellis, Nel and Chatterjee substantially disclose and teach the applicant's invention.

However, the combination does not specifically disclose and teach the vendor is a credit card company, nor the vendor notifies a service provider of a credit card transaction and the good or service purchased to provide the good or service.

On the other hand, Koreeda teaches a method of teach the vendor is a credit card company, nor the vendor notifies a service provider of a credit card transaction and the good or service purchased to provide the good or service.

It would have been obvious to one of ordinary skill to have provided the combination with the method of Koreeda to have enabled a method teach the vendor is a credit card company, nor the vendor notifies a service provider of a credit card transaction and the good or service purchased to provide the good or service. Therefore, one of ordinary

skill would have been motivated to extend the combination with a method teach the vendor is a credit card company, nor the vendor notifies a service provider of a credit card transaction and the good or service purchased to provide the good or service.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1 – 5, 8 – 20, 23 – 35 and 38 - 52 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Rob Rhode** whose telephone number is **(703) 305-8230**. The examiner can normally be reached Monday thru Friday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Wynn Coggins** can be reached on **(703) 308-1344**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **(703) 308-1113**.

Any response to this action should be mailed to:

***Commissioner for Patents***

***P.O. Box 1450***

***Alexandria, Va. 22313-1450***

or faxed to:

**(703) 872-9306** [Official communications; including  
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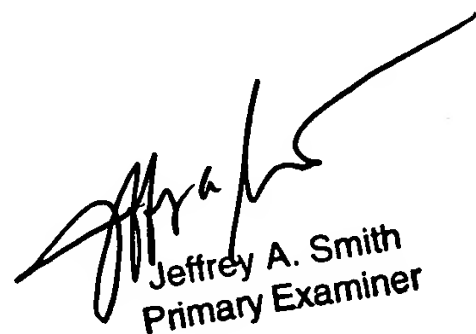
**(703) 746-7418** [Informal/Draft communications, labeled  
"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.

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Jeffrey A. Smith  
Primary Examiner